

Remarks

This Application has been carefully reviewed in light of the Office Action mailed October 27, 2005 (the "Current Office Action"). Applicants believe all pending claims are allowable without amendment and respectfully provide the following remarks. Applicants respectfully request reconsideration and allowance of all pending claims.

I. The Claims are Allowable over *Khan* under 35 U.S.C. § 103(a)

The Examiner rejects Claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2002/0018078 A1 by Khan, et al., (the "*Khan Publication*"). Applicants respectfully disagree.

A. *The Kahn Publication is Not Prior Art without Proper Support in the Kahn Provisional Application.*

As indicated in Applicants' response mailed July 29, 2005 (the "Previous Response"), the *Kahn Publication* has an actual filing date after the effective filing date of the Applicants' present Application. Therefore, the *Kahn Publication* cannot be used to reject Applicants' claims under 35 U.S.C. § 102(e) *unless there is "proper support for the subject matter as required by 35 U.S.C. 119(e) or 120"* in a priority document with a filing date earlier than the present Application (and subject to any possible swear behind). M.P.E.P. § 706.02(f)(1), Example 2 (emphasis added). In the present case, the *Kahn Publication* relies on Provisional Application 60/209,873 (the "*Kahn Provisional Application*") to establish priority.

In the Office Action mailed April 29, 2005 (the "Previous Office Action"), the Examiner rejected the present Application based solely on citations to the *Kahn Publication*. (See Previous Office Action, Pages 2-4) Applicants noted in the Previous Response that, in rejecting the claims of the present Application, the *Kahn Provisional Application* was not furnished with the Previous Office Action, and that no indication was given in the Previous Office Action of what, if any, elements in the *Kahn Provisional Application* provide "proper support for the subject matter" in the *Kahn Publication* used in rejecting the claims. Applicants then argued in the Previous Response that the *Kahn Provisional Application* failed to disclose, teach, or suggest various limitations recited in Applicants' independent claims.

In the Current Office Action, the Examiner's only response to Applicants' arguments regarding the deficiencies of the *Kahn Provisional Application* was: "Applicant is directed to the Public PAIR website, which allows the Applicant to directly access any provisional applications that are necessary." (Current Office Action, Page 9) Applicants emphasize that Applicants obtained a copy of the *Kahn Provisional Application* prior to responding to the Previous Office Action and made arguments based on the disclosures and deficiencies of the *Kahn Provisional Application* in the Previous Response.

In the Current Office Action, the Examiner modified the rejection of the claims from a rejection under 35 U.S.C. § 102(e) to a rejection under 35 U.S.C. § 103(a), but again only cited to the *Kahn Publication* as a basis for that rejection. (See Current Office Action, Pages 2-9) Again, there is no indication that the Examiner determined what the *Kahn Provisional Application*, as opposed to the *Kahn Publication*, did or did not disclose. Thus, no indication was given in the Current Office Action of what, if any, elements in the *Kahn Provisional Application* allegedly provide "proper support for the subject matter" in the *Kahn Publication* used in rejecting the claims.

Applicants respectfully submit that even if the *Kahn Publication* discloses the limitations recited in Claim 1 indicated by the Examiner in the Current Office Action (which Applicants certainly do not concede), the *Kahn Publication* would still fail to disclose, teach, or suggest each and every limitation recited in Claim 1 because at least certain of those alleged disclosures of the *Kahn Publication* are not supported by the *Kahn Provisional Application*, and are thus not prior art to Applicants' claims. Applicants reiterate below their arguments from the previous Response as to example deficiencies of the *Kahn Provisional Application*.

B. The *Kahn Provisional Application* Fails to Disclose, Teach, or Suggest Various Limitations Recited in Claim 1

The *Kahn Provisional Application* discloses a method for generating a customized network interface. (Page 3, Lines 3-4). The disclosed method allows a user to select portions of a web page, drag the selected portions into an information screen, and then store the information screen for later retrieval. (Page 3, Lines 6-10 and 22-24). However, the *Kahn*

Provisional Application fails to disclose, teach, or suggest each and every limitation recited in independent Claim 1. As an example, the *Kahn Provisional Application* fails to disclose, teach, or suggest “analyzing the web page to determine a *list of the associated elements*” or “*presenting the list* to a user,” as recited in independent Claim 1. Rather, the *Kahn Provisional Application* discloses, “When the user wishes to add content, a web-page chosen by the user is presented in operation 302. In operation 304, the user is then allowed to select the headline or hyperlink of his/her choice and simply drags and drops it into his/her portal.” (Page 18, Lines 23-26). The method disclosed in the *Kahn Provisional Application* merely presents a web page to a user in the format that it is typically seen in a browser. The method disclosed does not include any additional steps for presenting information to the user for selection by the user. The method disclosed in the *Kahn Provisional Application* cannot be construed as disclosing, teaching, or suggesting “analyzing the web page to determine a *list of the associated elements*” or “*presenting the list* to a user,” as recited in Claim 1. Accordingly, the *Kahn Provisional Application* fails to disclose, teach, or suggest each and every limitation recited in independent Claim 1. In addition, these limitations would not be obvious in view of the *Kahn Provisional Application*, which merely presents a web page.

C. Conclusions with Respect to the Section 103 Rejections

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 1 and its dependent claims. For at least certain analogous reasons, Applicants respectfully request reconsideration and allowance of independent Claims 9 and 14-17, and their dependent claims.

II. No Waiver

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicants are sufficient to overcome the Examiner’s rejections.

Conclusion


Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicants, at the Examiner's convenience at (214) 953-6813.

A check in the amount of \$120.00 is enclosed to cover the extension of time. Although Applicants believe no other fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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